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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/507,522

09/14/2004

Hidetoshi Hamamoto

2004-1425A

1134

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7590

04/27/2009

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EXAMINER

WEBB, WALTER E

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

04/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|----------------------------------------------------------------------------------------------|----------------------------------------------|------------------------------------------------|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | <p>Application No. 10/507,522</p> | <p>Applicant(s) HAMAMOTO ET AL.</p> | |
| | <p>Examiner WALTER E. WEBB</p> | <p>Art Unit 1612</p> | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,2,6,7,10 and 13-15.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612

/Walter E Webb/
Examiner, Art Unit 1612

Continuation of 3. NOTE: The proposed amendment would require further consideration since it is unclear what is meant by the term "sufficient solubility." The term is not defined by the claim or the specification. It is unclear how soluble the polyvalent metal salt has to be to qualify as sufficient. Accordingly, the term "polyvalent metal salt" raises, at a minimum, the new issue of indefiniteness for consideration. Moreover, the limitation "polyvalent metal salt" was not considered previously during the prosecution of the case. i.e. it adds something to the composition. It may be that this new limitation causes the composition to be novel over the prior art; it may be that the limitation is obvious in some way. Accordingly, it is unclear at this stage of prosecution how this element impacts the composition. New consideration of this issue will be required, and a new search may be required as well, to address these concerns.

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 USC 112, second paragraph, in regard to the use of the tradename "Macrogol" to refer to polyethylene glycol.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the crosslinking agent is not in an uncrosslinked state since it is in a gel, and the present invention is an ointment, not a cataplasm. However, the crosslinking agent is uncrosslinked prior to mixing with the crosslinking agent, which satisfies the limitation of the claim. The teachings of the reference are not limited to cataplasms, but include ointment preparations as well. Applicant argues that glycerin is not a bactericidal agent. However, glycerin itself is known for being "particularly useful for killing non-spore bearing bacteria" (see US 2,071,875, page 1, left column, lines 16-17). The fact that glycerin is used as a solvent does not negate the fact that it is also a bactericidal agent. Applicant argues that the use of polyacrylate is not a component of an ointment. However, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. The prior art composition comprises the claimed elements, and therefore meets the claims. In regard to the 103 rejection applicant argues that the sugars used in the present invention are not surfactants. However, limitations of the specification are not read into the claims. Sucrose qualifies as a sugar and therefore meets the limitation of the claims.